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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,682	08/22/2003	Dennis S. Fernandez	FERN-P013	1019
7590 02/28/2006				
Fernandez & Associates, LLP		EXAMINER		
PO Box D		MILLER, MARINA I		
Menlo Park, CA 94026-6402				
		ART UNIT		PAPER NUMBER
		1631		
DATE MAILED: 02/28/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/646,682

Applicant(s)

FERNANDEZ, DENNIS S.

Examiner

Marina Miller

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a system and a method, classified in class 702, subclass 19.
- II. Claim 11-20, drawn to a network biosensor, classified in class 703, subclass 11.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to related products. The related Inventions are distinct if the inventions as claimed do not overlap in scope, *i.e.*, are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, model of operation, function, or effect. See MPEP § 806.05(j). In the instant case, Invention I is drawn to a biosensor system comprising a sensor for sensing a biological target and a simulator for using a model to generate an output. Invention II is drawn to a network-biosensor comprising a sensor for receiving a signal for detecting a biological material and a controller for processing a platform for modeling a simulation model. Thus, product of Inventions I and II are not capable of use together, have a materially different design, model of operation, function, and effect.

Because these Inventions are distinct for the reasons given above, the classification is different, and the non-patent and patent literature search required for each group is not coextensive with that requirement for another group, restriction for examination purposes as indicated is proper.

*Species Election*

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: elect one sensor from among those recited, for example, in claims 12-13.

Species B: elect one simulation model from among those recited, for example, in claim 16.

Species C: elect one simulation data from among those recited, for example, in claim 17.

Species D: elect one manufacture-means from among those recited, for example, in claim 19.

Species E: elect one simulation application from among those recited, for example, in claim 20.

Species of group A, different type of sensors, are distinct because each sensor detects signals from different biological and chemical material, has different structure and function, and is generally disclosed in different art. Each sensor is independent and data generated from each sensor is expected to be different from the data generated by any other sensor.

Species of group B, different models, are distinct because each model is unrelated, requires different type of input data, and data generated from each model is expected to be different from the data generated by any other model.

Species C of group, different simulation data are distinct because data are independent and unrelated, have different structure, and output generated for each type of data is expected to be different from any other data.

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Species D, manufacture-means are unrelated, have different structure and function, and generally disclosed in different art.

Species E, simulation application are distinct because each application is independent and data generated from each simulation is expected to be different from the data generated by any other simulation.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (ONE) from EACH of groups A-E, above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1-11, 14-15, and 18 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Miller whose telephone number is (571)272-6101. The examiner can normally be reached on 8-5, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph. D. can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Miller  
Examiner  
Art Unit 1631

**MARJORIE A. MORAN**  
**PRIMARY EXAMINER**

*Marjorie A. Moran*  
*2/7/06*

MM